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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P56934

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Application Number

10/630759

Filed

31 July 2003

First Named Inventor

Richard G. Hyatt Jr.

Art Unit

3673

Examiner

Suzanne Lale Dino Barrett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

27,774

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Robert E. Bushnell

Typed or printed name

(202) 408-9040

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 5 pages are submitted.This collection is **Up to 5 pages including this Request**

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PRE-APPEAL BRIEF

Rejection of Claims 11 and 12 Double Patenting

Claims 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 90 and 120 of copending Application No. 08/720,070. This rejection is improper for the following reasons.

First, the Examiner states that the conflicting claims are not identical, but they are not patentably distinct from each other because they recite the same structure merely using different phraseology in certain instances. §806.01 of the *Manual of Patent Examining Procedure*, 8th Edition, Rev. 7 (August 2008) requires that,

“In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter ***must be compared*** in order to determine the question of distinctness or independence.”

Paper No. 20100325 however, provides no comparison of the four claims at issue. Applicant submits therefore, that Paper No. 20100326 fails to meet the requirement of 37 CFR §1.104(a) for thoroughness and §1.104 (b) for completeness. Designation of Paper No. 20100325 as “final” is thus premature.

Second, the comparison required by §806.01 of the *MPEP*, is shown in Tables 1 and 2 of Appellant’s Amendment After Final.

Table 1 established on the evidence present in this administrative record, that pending claim 11 and independent process claim 90 of Applicant’s copending parent application Serial No. 08/720,070, and are distinctive, and independent from one another. The Examiner’s attention is invited to observe that rejected dependent process claim 11 defines, *inter alia* aspects, Applicant’s:

- (i) “an electromechanical locking member substantially entirely contained within the barrel member,” and
- (ii) “providing at least one additional electromechanical locking member disposed in the barrel, the additional electromechanical locking member being also positionable to permit the side bar to engage the locking member in a non-barrel blocking position which permits the barrel to rotate with respect to the shell.”

Neither of these features are present within process claim 90 of Applicant’s parent application Serial No. 08/720,070. Consequently, this rejection of dependent process claim 11 is not supported by the administrative record, and is unsustainable.

Third, the instant application is a divisional application of No. 08/720,070, and co-pending No. 08/720,070 was subjected to a requirement that required the Applicant to chose between eight independent and distinct inventions on the basis of different drawings listed; each drawing contained one, or more, subassemblies which in some embodiments, are interchangeable between groups.

Although nothing in the administrative record has suggested that the rejected claims are not consonant with the requirement imposed under 35 U.S.C. §121 against Appellant’s ‘070 claims 90 and 120, the Court in *Boehringer Ingelheim Int’l. GmbH, et al. v. Barr Laboratories, Inc., et al.*, 592 F.3d 1340 (Fed. Cir. 2010) rejected the defendant’s argument that the safe harbor of 35 U.S.C. §121 applies only where an applicant “strictly follows an examiner’s election procedure and [does] not overlap claims to independent and distinct inventions in any single divisional application, and

the Court ruled that,

“[a]n overlap of claims to independent and distinct inventions within a given divisional applications is neither contrary to the restriction requirement nor relevant to the requirements of the third sentence of § 121.”

As stated by Judge Dyk, none of the three patents in the chain of divisional applications in *Boehringer* met the lines of demarcation for consonance with the restriction requirement because the claims prosecuted in the divisional applications were not limited to one of the groups of claims set in the original application. Rather, in *Boehringer* the two divisional applications contained non-overlapping combinations of claims from several of the groups.

As explained in the first and second arguments above, Appellant has common lineage in a divisional chain and has maintained the lines of demarcation between Claims 11 and 12 over claims 90 and 120 of copending Application No. 08/720,070.

Moreover, in addition to the structural distinctions noted in the Second argument, Appellant observes that claims 11 and 12 encompass the subject matter of non-elected Group defined by the multiple “electromechanical locking members” illustrated by Figure 1, rather than the structure illustrated by the elected Group.

Where, as here, one, or more, or a sequence of divisional patent applications filed as a result of a requirement for restriction imposed by the Office, or as in *Boehringer*, multiple divisional applications “encompassing various combinations of claims comprising the *different inventions* as being distinct in the restriction requirement assessed again the ... [parent] application,” the Appellant has satisfied the “as a result of” provision of 35 U.S.C. § 121. Moreover, *Boehringer* observed that the safe harbor provided by 35 U.S.C. § 121 applies “when the PTO issues a restriction requirement that leads to more than two separate applications” because 35 U.S.C. § 121 “refers broadly to *a divisional application*, and does not state that the divisional application must be a direct divisional of the original application, but extends to applications “sharing a common lineage ... or to continuation applications of divisional applications.”

Rejection Of Claims 10, 11 and 12 Under First Paragraph Of 35 U.S.C. § 112

The Examiner states that the specification fails to provide support for the “at least one electromechanical locking member” and “plurality of electromechanical locking members” set forth in claims 11 and 12, because,

“firstly, the solenoid coils 109, are not disclosed ‘locking members’ as argued by applicant. Secondly, the specification discloses that the ‘plurality’ of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug. See the specification on page 12, lines 11 -14 which clearly recites the use of locking member 106a or 107a or 108a.”

Specifically, the Examiner states that the specification fails to provide support for the “at least one electromechanical locking member” and “plurality of electromechanical locking members” set forth in claims 90 and 120, respectively.

There, the Examiner argues that,

“firstly, the solenoid coils 109, argued on page 69 of the amendment filed 2/24/03, are **not** disclosed ‘locking members’.”

The Examiner has confused the disclosure in the specification. With reference to Figure 3, by way of example, the “solenoid coils” are identified by reference numbers such as “106d” or “106D”, or in Figure 5A, “108b”, and in Figure 5, as “108b”. The entire assembly however, is readily described as “a plurality of electromechanical locking members.” Moreover, Applicant clearly illustrate three discrete versions of these plurality of electromechanical locking members in Figure 1, and nowhere negates use of more than a single one of these plurality of electromechanical locking members.

Attention is invited to consider the question of enablement discussed in *Arnold C. Bilstad, the Gorge Wakalopulos*, 386 F.3 1116 (Fed.Cir. 7 October 2004) where the Court noted “[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment.” Here, as in Bilstad, Applicant discloses a plurality of single assemblies that, unlike references of record such as Gokcebay ‘777 contains “a plurality of electromechanical locking members” as well as “at least one electromechanical locking member” as set forth in claims 90 and 120, respectively.

The Examiner further argues that,

“The specification discloses that the ‘plurality’ of locking members 106a, 107a, 108a are used alternatively and not as a plurality within the same plug.” See the specification on page 12, lines 11 -13 which clearly recites the use of locking member 106a or 107a or 108a.”

Applicant notes that the discussion on page 12, lines 11-13 is one small portion of the entirety of Applicant’s specification, and that portion describes the interchangeability of these assemblies in different embodiments. Nothing in Applicant’s page 12 negates the use of a plurality of any one of these embodiments or the use of two, or more, different ones of these embodiments.

Reference is made to *Lampi Corp. v. American Power Products, Inc.*, 228 F3d 1365, 1377-78 (Fed. Cir. 2000) which affirmed a District Court’s finding that disclosure of only identical half-shells were sufficient with description support for a claim in compassing both identical and non-identical half-shells. As a general rule, a disclosure of species provides sufficient written description support for a later filed claim directed to a genus.

Here, the Examiner seeks to ignore this general rule and instead, substitute a rule that disclosure of “one” invokes a “one and only one” limitation. This substitution was refuted by the U.S. Court of Appeals for the Federal Circuit, which held, in the interpretation of claims, “the use of the singular form “a” in conjunction with “comprising” and without narrowing language typically encompasses **both** singular and plural embodiments.”¹

More significantly, in *Hyperphase Technologies, LLC v. Google, Inc.*, 260 Fed. Appx. 274 (Fed. Cir. 2007), the Federal Circuit agreed that the patentee had defined the term “data reference” in the specification, but held that it was improper to add a “one and only” limitation because the use of the singular for “a” in conjunction with “comprising” and without narrowing language typically encompasses both singular and plural embodiments.

Appellant’s Figure 1, and the *Detailed Description* provide written enablement of both singular and plural use of Appellant’s “additional electromechanical locking member” of claims 11

¹ *Hyperphase Technologies, LLC v. Google, Inc.*, Case Nos 07-1125, -1176 (Fed.Cir. 26 December 2007) (Michel C. J.).

and 12.

Rejection of Claims 9 through 12 under 35 U.S.C. §103(a)

Claims 9 through 12 are rejected under 35 U.S.C. §103(a) as being rendered obvious, and thus unpatentable, over the Examiner's proposed combination of Gokcebay, U.S. Patent No. 5,552,777 in view of Thordmark *et al.*, U.S. Patent No. 5,542,274 and Naveda, U.S. Patent No. 4,416,127.

Claims 9 and 10

First, the proposed combination fails to make a *prima facie* showing of obviousness. Specifically, the proposed combination is singularly devoid of any teaching or suggestion of Applicant's:

“an electronically powered drive mechanism *cooperating with* the electromechanical locking member to selectively move the locking member from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member to rotate the barrel and operate the lock.”

Furthermore, neither the primary reference nor the secondary reference show any interaction between:

- Claim 9's “an electromechanical locking member *substantially entirely contained within* the barrel member,” or
- Claim 9's “an electronically powered drive mechanism *cooperating with* the electromechanical locking member to selectively move the *locking member* ... [to a] position in which **the side bar engages the locking member**,” or
- Claim 9's “an electronically powered drive mechanism *cooperating with* the electromechanical locking member to selectively move the *locking member* from the barrel blocking position to the non-barrel blocking position ...,” or
- Claim 9's “an electronically powered drive mechanism *cooperating with* the electromechanical locking member to selectively move the *locking member* from the barrel blocking position to the non-barrel blocking position in which the side bar engages the locking member.”
- Claim 10's “electronically powered drive mechanism located *within the barrel* member moving the *electromechanical locking member* to a position in which the groove of the *locking member* is aligned to receive the side bar.”

Instead, the Examiner's proposed combination, and Gokcebay, '777 teaches no cooperation between his solenoid and any “sidebar” while Thordmark *et al.*, '274 teaches mechanical locking members that cooperate with only a corresponding “side-bar 7.”

A distinct and independent electromechanical structure (“electric motor 12” or “electromagnet 17, 18”) of Thordmark has neither physical relation nor Appellant's *cooperating with* Thordmark's “side-bar 7;” instead, “electric motor 12” or “electromagnet 17, 18” of Thordmark cooperate with “latching element 10” and “blocking element 11.” Instead, Naveda, '127 teaches a different, single magnetic locking structure that requires three parallel axes, and thus,

contrary to the Examiner's assertions, must be physically larger than the single axis structures of Appellant, Gokcebay, '777 and Thordmark *et al.* '274.

Moreover, the Examiner's proposed combination requires either Gokcebay '777's "blocking pin 38" (*i.e.*, the armature of Gokcebay's solenoid 36) that physically and directly engages both the cylinder plug and its surrounding shell, or Thordmark '274's "electric motor 12" or "electromagnet 17, 18" that are housed wholly external to the cylinder plug, and can not therefore make a *prima facie* showing of Appellant's "electromechanical locking member ***substantially entirely contained within*** the barrel member," as defined by claims 9 and 10.

Furthermore, the Examiner's proposed combination can not alter the primary reference to incorporate the foregoing features of claims 9 or 10 without impermissibly preventing the primary reference for operating in its intended mode that requires "bore or recess 50 into which the blocking pin 38 extends [from the cylinder plug and into the surrounding shell in order to place the lock] in the blocking position." Gokcebay '777, column 6, lines 45 and 46.²

There is no actual teaching in the Examiner's proposed combination for shifting "a spring biased sidebar 10" anywhere; the primary reference does not require a sidebar and can not fit a sidebar between its blocking pin 38 and its recess 50 without interfering with functional operation; Thordmark '274 already has a "side-bar 7" which has no disclosed relation with its "electronic operator 12"; and Naveda '127 neither discloses nor indicates any need for a sidebar, whether biased or unbiased. Absent the requisite evidence of motivation for making the Examiner's proposed combination, this rejection may not be sustained.

Alternatively, if the Examiner has intended to assert that the proposed combination may be constructed with a wholesale substitution of "electrical operator 12, a movable electronic [*sic*] locking member 11" and latch 10 for the primary reference's "electrical operator 36 ... [and] member 38", the Examiner's proposed combination is flawed because it impermissibly prevents the primary reference from operating in its intended mode of operation with "a bore or recess 50 [drilled into, or preferable through cylinder shell 46] into which blocking pin 38 extends in the blocking position" (*i.e.*, to directly and securely engage the cylinder shell) and concomitantly impermissibly prevents the primary reference from retentively holding "blocking pin 38" in a retracted position when energized. There is no evidence of record teaching this construction and concomitant modification of Gokcebay '777, except that provided by Appellant's claims alone among the art.³

² The Examiner's proposed combination would impermissibly prevent the primary reference from operating in its intended mode of operation by obstructing the ability of the "block pin 38" of "small solenoid 36" of the primary reference to engage its cylinder shell 46.

³ The Examiner's "obvious reversal of parts and change of size to select miniature logic circuitry and a miniature solenoid and locking member 11 such that the blocking mechanism fits with a conventional sized lock plug as taught by Gokcebay and Naveda" is fictitious and illusory, because there is no evidence of record which either teaches or suggest the "obvious reversal."